

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EIICHI MACHIDA

Appeal No. 1998-2826
Application No. 08/598,687¹

ON BRIEF

Before STAAB, MCQUADE and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed February 8, 1996.

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This is a decision on an appeal from the examiner's final rejection of claims 3 through 6, which are all of the claims pending in this application.

We REVERSE.

Appellant's invention relates to

an ingrown nail correcting device including an elongated plate member that is adhesively bonded to the surface of an ingrown nail. The plate member is made of a material having a curved shape at room temperature that deforms to a memorized flat shape when heated above room temperature. (Brief, pages 2 and 3)

Claim 3, the only independent claim, is illustrative of the subject matter on appeal and is reproduced below:

3. An ingrown nail correcting device comprising an elongated plate member [10] adhesively bonded to a surface of a nail shell [12] with an adhesive agent [13], said plate member [10] having a curved shape bent to match a curvature of said nail shell [12] at room temperature, and said plate member [10] is made of a material having said curved shape at room temperature and deforming to a memorized flat shape when heated above room temperature. (Reference numerals added)

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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Chikama	4,601,283	Jul. 22, 1986
McCoy	4,944,727	Jul. 31, 1990

Claims 3 through 6 stand rejected under 35 U.S.C. §
103(a) as being unpatentable over Chikama in view of McCoy.²

The full text of the examiner's rejection and the responses to the arguments presented by appellant appear in the final rejection (Paper No. 6, mailed July 9, 1997) and the answer (Paper No. 12, mailed March 16, 1998), while the complete statement of appellant's arguments can be found in the brief (Paper No. 10, filed February 9, 1998).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the

² The rejection of claims 3 through 6 under 35 U.S.C. § 112, second paragraph, made in the final rejection has been withdrawn. See Paper No. 9.

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respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is

our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to independent claim 3. Accordingly, we will not sustain the examiner's rejection of claim 3, and claims 4 through 6 dependent thereon, under 35 U.S.C. § 103. Our reasoning for this determination follows.

Chikama discloses:

an endoscope having a long flexible image guide, such as a colon endoscope, in which a shape memory alloy [26] is built in a flexible tube [22] in which the image guide is inserted. When the flexible tube is inserted in the deep portion of a complicatedly bent organ such as the colon, the flexible tube which is partially bent according to the bending of the colon or the like is straightened by utilizing the restoring property of the shape memory alloy to straighten the correspondingly bent portion of the colon or the like, whereby the flexible tube can easily be inserted in the complicatedly bent portion

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of the colon or the like while straightening this portion. (Abstract, references numerals added).

McCoy discloses a guide apparatus, probe, and the like that is steerable through body cavities having a plurality of temperature activated memory elements (20, Fig. 3) formed of a mechanical memory metal, e.g., nickel titanium alloy (col. 5, lines 31 and 32). McCoy specifically teaches that the elements (20) may be in the form of wires or flat strips (col. 5, lines 28 and 29). As McCoy explains it

[e]ach temperature-activated memory element 20 is originally annealed into its preset shape (represented by the broken lines in FIG. 3). Memory elements 20 are cooled and straightened to their second shape (represented by the solid lines in FIG. 3) before incorporation into the distal end 16 of the tubular member 12. When the elements 20 are again heated to a predetermined transitional temperature they return to their preset shape. By applying an opposing force to an element 20 that has moved to assume its preset shape

it can be moved to its second shape (represented by the solid lines in FIG. 3). In the illustrative embodiment, the predetermined transitional temperature is any temperature above body temperature. For example, the predetermined transitional temperature may be in the range of 100E to 150E F. (Col. 5, lines 46-61).

The examiner has concluded that

it would have been obvious to one of ordinary skill in the art at the time of [appellant's] invention to provide

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the memory allow [sic, alloy] of Chikama in the form of an elongated plate [as taught by McCoy] in order to allow the memory alloy to maneuver its way into and through parts of the human body. (Final rejection, pages 3 and 4)

In applying the prior art to claim 3, the examiner has taken the position that the claim language requiring the elongated plate to be "adhesively bonded to a surface of a nail shell with an adhesive" is "mere intended use and is considered to have no limiting effect" (answer, page 3) and that the claim does not include either a nail shell or an adhesive agent (id. at 4).

Appellant, on the other hand, argues (brief, pages 7-9) that claim 3 positively requires that the elongated plate be adhesively bonded to a surface of a nail shell with an adhesive agent and that neither of the applied references teaches nor suggests such a combination. We agree.

In order to establish the prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Every limitation positively

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recited in a claim must be given effect in order to determine what subject matter that claim defines. In re Wilder, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). The language "an elongated plate member adhesively bonded to a surface of a nail shell with an adhesive agent" in claim 3 is not a statement of intended use, but a positive limitation which cannot be ignored in applying prior art.

The examiner is of the opinion that the recitation of a "nail shell" can be ignored in applying the prior art because a "nail shell" is a part of the human body, thus non-statutory subject matter (answer, pages 4 and 5). This approach is untenable as explained in In re Miller, 418 F.2d 1392, 1396, 164 USPQ 46 (CCPA 1969). The Miller case involved a rejection of claims to the combination of a measuring device, indicia specifying a given volume and a legend specifying the ratio of the given volume to the actual volume of the measuring device.

As in this case, the examiner in the Miller case refused to give any patentable weight to what the examiner considered to be non-statutory subject matter, that is, the printed matter

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provided on the measuring device. The court clearly rejected the examiner's approach. As stated by the court in Miller, 418 F.2d at 1396, 164 USPQ at 49, "[t]he fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination." We believe the same rationale applies in this case, that is, the recitation of a "nail shell" in claim 3 cannot be ignored in the appealed claims simply because the examiner considers a "nail shell", per se, to be non-statutory subject matter.

Since all the limitations of appellant's claim 3 are not found in the applied prior art or obvious therefrom, it follows that the examiner's rejection of claim 3 under 35 U.S.C. § 103 will not be sustained.

Claims 4 through 6 are dependent on claim 3 and contain all of the limitations of that claim. Therefore, we will also not sustain the standing 35 U.S.C. § 103 rejection of claims 4 through 6.

CONCLUSION

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To summarize, the rejection of claims 3 through 6 under
35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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JOHN P. MCQUADE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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